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Paper No. 29

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FEB 13 2004

OFFICE OF PETITIONS

In re Application of
David Andrew D'Zmura
Application No. 09/849,582
Filed: May 5, 2001
Attorney Docket No.: None
Title: METHOD OF DETERMINING
ZODIAC SIGNS

DECISION ON SECOND RENEWED
PETITIONS UNDER 37 C.F.R.
§§1.137(A) AND C.F.R. §1.137(B)

This is a decision on the second renewed petitions under 37 CFR §§1.137(a)¹ and 1.137(b)², both filed concurrently on January 9, 2003.

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance and Issue Fee Due (notice), mailed June 2, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time are permitted for transmitting issue fees³. Accordingly, the above-identified application became abandoned on September 3, 2003.

1 A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

2 A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

3 See MPEP §710.02(e).

On September 8, 2003, petitioner filed the original petition under 37 C.F.R. §1.137(a).

On September 22, 2003, the petition under 37 C.F.R. §1.137(a) was dismissed for failure to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

The following was set forth:

The petitioner has asserted financial difficulty in that he lacked the funds necessary to pay the issue fee. A showing of "unavoidable" delay based upon financial difficulty must establish that petitioner lacked the financial resources to pay the fee(s) associated with patent prosecution. Such a showing must be supported by a complete and thorough (emphasis included) showing of his financial condition during the entire period between June 2, 2003 and September 8, 2003, including income, expenses, tax return statements, bank records, assets, credit and obligations, which made the delay in payment of the fee(s) unavoidable. Petitioner should provide copies of all documents or records pertaining to each of these so as to confirm the financial difficulty.

Decision on original petition, page 4.

On October 10, 2003, the renewed petitions under 37 C.F.R. §§1.137(a) and 1.137(b) were filed. Regarding the former, the petition was dismissed for failure to indicate whether he maintains any other bank accounts, reveal his income during the relevant time frame, delineate his expenses, and to list credits or obligations. The latter was granted. On November 17, 2003, the portion of the decision which granted the latter was vacated, as the credit card which Petitioner provided was declined.

The second renewed petition under 37 C.F.R. §1.137(a):

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."⁴

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked **any** basis in reason or common sense."⁵

4 *Rydeen v. Quigg*, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing *Morganroth v. Quigg*, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); *Ethicon, Inc. v. Quigg* 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency's interpretation of a statute it administers is entitled to deference"); see also *Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc.*, 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")

5 *Commissariat A L'Energie Atomique et al. v. Watson*, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

“The court’s review of a Commissioner’s decision is ‘limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.’”⁶

“The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency.”⁷

The standard

“[T]he question of whether an applicant’s delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account.”⁸

The general question asked by the Office is: “Did petitioner act as a reasonable and prudent person in relation to his most important business?”⁹ Nonawareness of a PTO rule will not constitute unavoidable delay¹⁰

The burden of showing the cause of the delay is on the person seeking to revive the application¹¹.

A delay caused by an applicant’s lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered “unavoidable” due to either the applicant’s reliance upon oral advice from USPTO employees or the USPTO’s failure to advise the applicant to take corrective action¹².

6 Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct. 1241, 1244 (1973) (citing 5 U.S.C. 706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir. 1982)).

7 Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

8 Id.

9 See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

10 See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel’s nonawareness of PTO rules does not constitute “unavoidable” delay). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

11 Id.

12 See In re Sivertz, 227 USPQ 255, 256 (Comm’r Pat. 1985).

Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present¹³.

In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account¹⁴.”

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable¹⁵.”

The rule and portion of the MPEP relevant to the abandonment of this application

37 CFR 1.311. Notice of Allowance.

- (a) If, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant at the correspondence address indicated in 37 C.F.R. §1.33. The notice of allowance shall specify a sum constituting the issue fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. The sum specified in the notice of allowance may also include the publication fee, in which case the issue fee and publication fee (37 C.F.R. § 1.211(f)) must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.

710.02(e) Extension of Time

- (c) If an applicant is notified in a “Notice of Allowability” that an application is otherwise in condition for allowance, the following time periods are not extendable if set in the “Notice of Allowability” or in an Office action having a mail date on or after the mail date of the “Notice of Allowability”:
- (2) The period for submitting formal drawings set under 37 C.F.R. §1.85(c).

Application of the standard to the current facts and circumstances

In the second renewed petition, petitioner continues to maintain that the circumstances that led to the abandonment of the application meet the aforementioned unavoidable standard and, therefore; petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner contends that the funds required to submit the issue fee were not available until after the expiration of the period of reply.

¹³ *In re Mattullath*, 38 App. D.C. at (1912)(quoting *Ex parte Pratt*, 1887 Dec. Comm’r Pat. 31, 32-33 (1887)); see also *Winkler v. Ladd*, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), *aff’d*, 143 USPQ 172 (D.C. Cir. 1963); *Ex parte Henrich*, 1913 Dec. Comm’r Pat. 139, 141 (1913).

¹⁴ *Smith v. Mossinghoff*, 671 F.2d at 538; 213 USPQ at 982.

¹⁵ *Haines*, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

The statement of facts submitted with the original petition set forth that when the applicant received the notice, he did not have the necessary funds in the forms of cash, his savings account, checking account, or credit cards. On August 16, 2003, petitioner attempted to sell his car to a dealership. Petitioner ended up purchasing a new car, leaving his old car at the dealer with instructions to return on August 21st to pick up a check for \$3,700. Petitioner returned as directed, only to have his new car repossessed by the dealer, and his old car returned to him. Obviously, the check in question was not provided to the applicant. On September 4, 2003, petitioner managed to sell his car for \$3,500, and the original petition was filed shortly thereafter.

Petitioner's arguments have been considered, and has been deemed to be unpersuasive.

Petitioner has submitted, *inter alia*, a 2002 tax statement which shows a net loss of over seven million dollars;¹⁶ a narrative which describes attempted murder and a plurality of assorted intrigues; a reporting of zero income over the relevant time frame, and; a statement that no bank accounts have been maintained since the closure of the Bank of America account.

Furthermore, Petitioner has not submitted the required tax return statement for 2003.

As such, the Office cannot determine whether the petitioner had the requisite funds during the relevant time period, or if he had any financial obligations which would have prevented the submission of the issue fee.

Consequently, the petition is **DISMISSED**.

It is highly recommended that Petitioner prepare a chart which delineates his income and expenses **in a clear and concise manner**. The chart should reveal a **complete and thorough** showing of his financial condition during the entire period between June 2, 2003 and the date on which the third renewed petition is submitted to the Office. Petitioner should ensure that all information as to his financial condition is current as of and updated to the date on which this third renewed petition is submitted to the Office. The chart should include the sale of his car, where the proceeds went, his utilities, gifts from his parents, his rent, his auto insurance, etc.

All matter which is not germane to his financial condition should be omitted from Petitioner's submission.

The petition under 37 C.F.R. §1.137(b)

Petition fee requirement

The fee for filing a petition to revive an unintentionally abandoned application under 37 C.F.R. § 1.137(b) is set forth in 37 C.F.R. §1.17(m) as being one thousand and three-hundred dollars (\$1,300.00) for a large entity and six hundred and fifty dollars (\$650.00) for a small entity. As no fee has been submitted with the filing of this third renewed petition, requirement number (2) above has not been met.

¹⁶ On third renewed petition, it is recommended that Petitioner explain why someone who is destitute has over seven million dollars to lose.

The payment of the required petition fee is a prerequisite to the filing of a petition to revive under 37 C.F.R. §1.137. Therefore, consideration of the merits of the petition before receipt of the filing fee would be premature. See M.P.E.P. 711.03(c)(III)(B)¹⁷

In view of the foregoing, this petition is **DISMISSED**.

It does not appear that Petitioner will be able to meet the stringent requirements imposed by 37 C.F.R. §1.137(a). Petitioner's only relief is a petition under 37 C.F.R. §1.137(b), and - having been made aware of this reality - Petitioner's delay in promptly seeking relief under 37 C.F.R. §1.137(b) may be considered evidence of intentional delay and an absolute bar to revival.

NOTICE:

Any request for reconsideration of this decision under 37 C.F.R. §1.137(a) must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Failure to respond will result in abandonment of the application. The request for reconsideration should include a cover letter entitled "Third Renewed Petition under 37 C.F.R. §1.137(a)," and should only address the deficiencies noted in this decision.

Thereafter, there will be no further reconsideration of this matter^{18, 19}.

The reply to this letter may be submitted by mail²⁰, hand-delivery²¹, or facsimile²². Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Third Renewed Petition Under 37 CFR §§1.137(a) and/or (b)". This is not a final agency action within the meaning of 5 U.S.C 704.

¹⁷ "...[T]he payment of a petition fee to obtain the revival of an abandoned application is a statutory prerequisite to revival of the abandoned application and cannot be waived. In addition, the phrase '[o]n filing' in 35 U.S.C. §41(a)(7) means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 C.F.R. §1.137. See H.R. Rep. No. 542, 97th Cong., 2nd Sess. 6 (1082), *reprinted in* 1982 U.S.C.C.A.N. 770 ('[t]he fees set forth in this section are due on filing the petition'). Therefore, the Office...will not reach the merits of any petition under 37 C.F.R. §1.137 lacking the requisite petition fee."

¹⁸ For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Loudon, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

¹⁹ If, on the second request for reconsideration, Petitioner fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. §1.137(e), will **not** apply to that decision.

²⁰ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

²¹ Office of Petitions, 2201 South Clark Place, Crystal Plaza 4, Suite 3C23, Arlington, VA 22202.

²² (703) 308-6916 or (703) 305-4257, Attn: Office of Petitions.

The application file will be retained in the Office of Petitions for two (2) months.

Again, if the third renewed petition(s) are not granted, a Final Agency Action shall be issued, and there will be no further reconsideration of this matter.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.



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